

Docket No.: 60680-1812

Application No. 10/708,054

REMARKS

This response is intended to be fully responsive to the Office Action having a mailing date of March 22, 2006, wherein claims 1-14 were rejected and are currently pending. No new matter has been added by this amendment. Applicant respectfully requests reconsideration in view of the following remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 1-14 were rejected under 35 U.S.C. § 103(as) as being unpatentable over *Sasaki et al.* (6,649,097) in view of *Barton et al.* (6,057,054). Applicant respectfully traverses this rejection.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: "To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." The initial burden in presenting a *prima facie* case of obviousness is on the examiner. *In re Oetiker*, 977 F.2d 1443, 1443 (Fed. Cir. 1992). Here, the Examiner has failed to show any motivation or suggestion in the art to make the combination of art upon which she is relying.

No Motivation for the Proposed Combination

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, there must be "something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998).

In re Fritch provides that "the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art," and that "the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally

Application No. 10/708,054

Docket No.: 60680-1812

available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." 23 USPQ2d. 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit has concluded that "under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (Emphasis in original).

Despite the Examiner's burden to do so, the office action has provided no motivation for the proposed combination. Nor does the Examiner point to any suggestion in the prior art to make the proposed combination. In fact, a review of the references establish that there is no motivation to make the proposed combination.

Sasaki teaches a method of making a gasket for layer-built fuel cells. The gasket is provided on a porous sheet in one body. The gasket is made of liquid rubber and has a hardness not more than 60 and can be made by injection molding. (See Abstract) As admitted by the Examiner on page 3 of the Office Action, *Sasaki* does not set forth the making of a gasket for a membrane electrode assembly (MEA), nor does it provide any suggestion or motivation to make a bipolar plate module that includes an MEA according to independent claims 1 and 7.

Barton teaches discloses a membrane electrode assembly having a coextensive ion exchange membrane disposed between porous electrode layers and a resilient fluid impermeable integral seal made by impregnating a sealing material into the porous electrode layers along the perimetric regions of the layers (Col. 3, lns. 13-29). *Barton* does not provide disclosure or suggestion of utilizing a sealing material to form a distinct sealing layer between anode and cathode plates as according to independent claims 1 and 7. Accordingly, independent claims 1 and 7 and their respective independent claims are not obvious in view of the cited references as the references provide no motivation or suggestion to combine their teachings. As such, Applicant respectfully requests that this rejection be withdrawn and the claims passed to issue.

Conclusion

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal.


Docket No.: 60680-1812

Application No. 10/708,054

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1812 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: 6/21/06

Respectfully submitted,

By 
Kristin L. Murphy, Reg. No. 41,212
RADER, FISHMAN & GRAUER PLLC
39533 Woodward Avenue, Suite 140
Bloomfield Hills, Michigan 48304
(248) 594-0600
Attorney for Applicant

R0358990.DOC